

Interview Summary	Application No.	Applicant(s)	
	10/044,639	AKERLUND, TOR JAN	
	Examiner	Art Unit	
	Jennifer H Gay	3672	

All participants (applicant, applicant's representative, PTO personnel):

(1) Jennifer H Gay. (3) Jason Huang.
 (2) Bruce Patterson. (4) David Hougan.

Date of Interview: 20 May 2004.

Type: a) Telephonic b) Video Conference
 c) Personal [copy given to: 1) applicant 2) applicant's representative]

Exhibit shown or demonstration conducted: d) Yes e) No.
 If Yes, brief description: Attachment A (Purposed Amendment).

Claim(s) discussed: _____.

Identification of prior art discussed: US 3,840,128; US 3,881,275; US 2,615,681; US 3,505,913.

Agreement with respect to the claims f) was reached. g) was not reached. h) N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

 Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant's attorney contacted the examiner regarding the Final Rejection mailed 4/8/04 and the proposed response to that Office Action (Attachment A). After a review of the arguments presented in the response and consulting her supervisory, the examiner informed applicant's attorney that she would be withdrawing finality and sending out a new rejection. The examiner further stated that she believed that Swoboda, Jr. et al. (US 3,840,128) meet the structural limitations of the claimed "apparatus" and that using the apparatus to move a tong was the invention. However, since applicant has argued that the "gripping member" of Swoboda is not a tong the examiner will present a rejection in the new Office Action that show that replacing the "gripping member" of Swoboda with a tong would be obvious. The examiner stated that some of the references she was considering were US 3,881,275, US 2,615,681, and US 3,505,913. Applicant to wait for new Office Action.

May-18-04 04:39pm From-Moser, Patterson & Sheridan L.L.P.

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FACSIMILE COVER SHEET

DATE: May 18, 2004
FILE NO: MRKS/0032.C1
TO: Examiner Jennifer Gay
FAX NO: 703-746-3660
COMPANY: USPTO
FROM: Jason C. Huang
PAGE(S) with cover: 11
ORIGINAL TO FOLLOW? YES NO

PROPOSED RESPONSE TO OFFICE ACTION

Attached for your review is a Proposed Response to Office Action Dated April 8, 2004.

U.S. Serial No.: 10/044,639
Conf. No.: 9370
Attorney Dkt. No.: MRKS/0032C1
Applicants: Tor Jan Akerlund
Filed: January 10, 2002
Entitled: Apparatus for Positioning a Tong and Drilling Rig Provided with such an Apparatus

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274893_1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re Application of:
Tor Jan Akerlund**

Serial No.: 10/044,639

Confirmation No.: 9370

Filed: January 10, 2002

For: Apparatus For Positioning
A Tong And Drilling Rig
Provided With Such An
Apparatus

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Group Art Unit: 3672

Examiner: Gay, Jennifer Hawkins

Customer No.: 36,735

**CERTIFICATE OF FACSIMILE
TRANSMISSION UNDER 37 CFR 1.8**

Dear Sir:

PROPOSED
RESPONSE TO OFFICE ACTION DATED APRIL 8, 2004

In response to the Office Action dated April 8, 2004, having a shortened statutory period for response set to expire on July 8, 2004, please enter this Response and reconsider the claims pending in the application for reasons discussed below. Although Applicant believes no fees are due in connection with this response, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 20-0782/MRKS/0032.C1/WBP for any fees necessary to make the submission of this response timely and acceptable to the Office.

Amendments to the claims are reflected in the listing of claims beginning on page 2.

Remarks begin on page 9.

IN THE CLAIMS:

1. (Previously Presented) An apparatus for positioning a tong, comprising:
at most one cantilevered extendable structure, the tong attached to one end of the extendable structure;
an actuating member for extending or retracting the extendable structure; and
a mounting assembly coupled to an opposite end of the extendable structure.
2. (Original) The apparatus of claim 1, wherein the extendable structure is telescopic.
3. (Original) The apparatus of claim 2, wherein the extendable structure is pivotable about a vertical axis.
4. (Original) The apparatus of claim 2, wherein the extendable structure is pivotable about a horizontal axis.
5. (Original) The apparatus of claim 2, wherein the telescopically extendable structure comprises an outer barrel and an inner barrel.
6. (Original) The apparatus of claim 5, wherein the telescopically extendable structure further comprises an intermediate barrel.
7. (Original) The apparatus of claim 6, wherein at least a portion of the inner barrel is slidably mounted in the intermediate barrel and at least a portion of the intermediate barrel is slidably mounted in the outer barrel.
8. (Original) The apparatus of claim 5, wherein the mounting assembly comprises:
a base; and

a carriage pivotally attached to the base, wherein a portion of the outer barrel is disposed on the carriage.

9. (Original) The apparatus of claim 8, wherein the tong is movably attached to the inner barrel.

10. (Original) The apparatus of claim 9, further comprising a clamp assembly for securing the outer barrel to the carriage.

11. (Original) The apparatus of claim 10, wherein the outer barrel is movable between a first position and a second position relative to the carriage.

12. (Original) The apparatus of claim 1, wherein the mounting assembly comprises:

a base; and

a carriage pivotally attached to the base, wherein a portion of the extendable structure is disposed on the carriage.

13. (Original) The apparatus of claim 12, further comprising a clamping assembly for securing the extendable structure to the carriage.

14. (Original) The apparatus of claim 13, wherein the clamping assembly is releasably connected to the carriage.

15. (Original) The apparatus of claim 14, wherein the extendable structure comprises an outer barrel and an inner barrel.

16. (Original) The apparatus of claim 15, wherein the extendable structure further comprises an intermediate barrel.

17. (Original) The apparatus of claim 16, wherein at least a portion of the inner barrel is slidably mounted in the intermediate barrel and at least a portion of the intermediate barrel is slidably mounted in the outer barrel.

18. (Original) The apparatus of claim 14, wherein the extendable structure is pivotable about a vertical axis.

19. (Original) The apparatus of claim 14, wherein the extendable structure is pivotable about a horizontal axis.

20. (Original) The apparatus of claim 1, further comprising a motor actuatable to adjust the position of the extendable structure with respect to said mounting assembly.

21. (Previously Presented) The apparatus of claim 1, wherein the actuating member comprises a piston and cylinder assembly.

22. (Original) The apparatus of claim 21, wherein the piston and cylinder assembly is at least partially disposed on the extendable structure.

23. (Original) The apparatus of claim 21, wherein the piston and cylinder assembly is used to move the extendable structure horizontally.

24. (Original) The apparatus of claim 1, wherein the tong is movably attached to the extendable structure.

25-34. (Cancelled without prejudice).

35. (Previously Presented) An apparatus for positioning a tong, comprising:
at most one cantilevered extendable structure, the extendable structure having a variable length and the tong attached to one end of the extendable structure;
a motive assembly for changing the length of the extendable structure; and

a mounting assembly coupled to an opposite end of the extendable structure.

36. (Original) The apparatus of claim 35, wherein the tong is movably attached.

37. (Original) The apparatus of claim 35, wherein the motive assembly comprise a piston and cylinder assembly.

38. (Previously Presented) An apparatus for positioning a tong, comprising:
an extendable boom, the tong attached to one end of the extendable boom,
wherein a center of mass of the tong is substantially aligned with an axis of the
extendable boom;

an actuating member for extending or retracting the extendable boom; and
a mounting assembly coupled to an opposite end of the extendable boom.

39. (Previously Presented) The apparatus of claim 38, wherein the extendable
boom is telescopic.

40. (Previously Presented) The apparatus of claim 39, wherein the extendable
boom is pivotable about a vertical axis.

41. (Previously Presented) The apparatus of claim 39, wherein the extendable
boom is pivotable about a horizontal axis.

42. (Previously Presented) The apparatus of claim 39, wherein the telescopically
extendable boom comprises an outer barrel and an inner barrel.

43. (Previously Presented) The apparatus of claim 42, wherein the telescopically
extendable boom further comprises an intermediate barrel.

44. (Previously Presented) The apparatus of claim 38, wherein the mounting
assembly comprises:

a base; and

a carriage pivotally attached to the base, wherein a portion of the extendable boom is disposed on the carriage.

45. (Previously Presented) The apparatus of claim 44, further comprising a clamping assembly for securing the extendable boom to the carriage.

46. (Previously Presented) The apparatus of claim 45, wherein the clamping assembly is releasably connected to the carriage.

47. (Previously Presented) The apparatus of claim 38, further comprising a motor actuatable to adjust the position of the extendable boom with respect to said mounting assembly.

48. (Previously Presented) The apparatus of claim 38, wherein the actuating member comprises a piston and cylinder assembly is at least partially disposed on the extendable boom.

49. (Previously Presented) The apparatus of claim 48, wherein the piston and cylinder assembly is used to move the extendable boom horizontally.

50. (Previously Presented) An apparatus for positioning a tong, comprising:
at most one extendable beam structure, the extendable beam having a variable length and the tong attached to one end of the extendable beam structure;
a motive assembly for changing the length of the extendable beam structure; and
a mounting assembly coupled to an opposite end of the extendable beam structure.

51. (Previously Presented) The apparatus of claim 50, wherein the tong is movably attached.

52. (Previously Presented) The apparatus of claim 50, wherein the motive assembly comprise a piston and cylinder assembly.

53. (Previously Presented) The apparatus of claim 50, wherein the extendable beam structure is movable in at least two planes.

54. (Previously Presented) The apparatus of claim 50, wherein the extendable beam structure is slidable along the mounting assembly between a first position and a second position.

55. (Previously Presented) The apparatus of claim 50, wherein the extendable beam structure is movable in at least two planes.

56. (Previously Presented) The apparatus of claim 50, wherein the extendable beam structure is slidable along the mounting assembly between a first position and a second position.

57. (Previously Presented) The apparatus of claim 50, wherein the extendable beam structure is telescopic.

58. (Previously Presented) A method of positioning a tong, comprising:
providing at most one extendable beam structure having a variable length;
attaching the tong to a first end of the extendable beam structure;
coupling a second end of the extendable beam structure to a mounting assembly; and
moving the tong from a first position to a second position.

59. (Previously Presented) The method of claim 58, wherein the extendable beam structure is telescopic.

60. (Previously Presented) The apparatus of claim 1, wherein a center of mass of the tong is substantially aligned with an axis of the extendable structure.

61. (Previously Presented) The apparatus of claim 50, wherein a center of mass of the tong is substantially aligned with an axis of the extendable beam structure.

62. (Previously Presented) A tong assembly, comprising:
an extendable boom;
a tong mountable at one end of the boom;
wherein a center of mass of the tong is alignable with a longitudinal center line of the boom when the tong is mounted on the boom.

63. (Previously Presented) An apparatus for positioning a tong, comprising:
only one extendable beam structure, the extendable beam having a variable length and the tong attached to one end of the extendable beam structure;
a motive assembly for changing the length of the extendable beam structure; and
a mounting assembly coupled to an opposite end of the extendable beam structure.

REMARKS

This is intended as a Response to the Office Action dated April 8, 2004. Claims 1-24 and 35-63 remain pending after entry of this response. Please reconsider the claims pending in the application for reasons discussed herein.

Claims 38-49 and 60-62 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description. The Examiner states that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states that the limitation "center of mass of the tong is substantially aligned with an axis of the extendable boom is not found in the specification or the drawings.

Applicant respectfully traverses this rejection. Figures 4 and 5 show an embodiment of the apparatus wherein a center of mass of the tong is substantially aligned with an axis of the extendable boom, as recited in claims 38-49 and 60-62. Withdrawal of the rejection is respectfully requested.

Claims 1-24 and 35-63 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Swoboda*, U.S. Patent No. 3,840,128. The Examiner states *Swoboda* discloses an apparatus for positioning a wellbore tubular gripping assembly. The apparatus includes the following features:

- A cantilevered extendable boom 36 with the gripping assembly attached to the end thereof.
- An actuating member for extending and retracting the extendable boom.
- A mounting assembly coupled to an opposite end of the boom.

Applicant respectfully traverses this rejection. *Swoboda* discloses a racking arm having a pipe gripping head secured to an end of the arm. The racking arm guides movement of wellbore tubulars from various storage positions to the wellbore. The gripping head may be adapted to clamp the tubular for lateral movement while allowing

the tubular to slide vertically along their axis, or to tightly grip the tubular for transportation. *Swoboda* does not disclose a tong, but simply a gripping member. *Swoboda* does not teach making up or breaking out a tubular joint with the gripping head. Therefore, *Swoboda* does not teach, show, or suggest the apparatus or methods claimed in claims 1-24 and 35-63. Withdrawal of the rejection is respectfully requested.

In conclusion, the reference cited by the Examiner, does not teach, show, or suggest the apparatus of the present invention.

Having addressed all issues set out in the office action, Applicant respectfully submits that claims 1-24 and 35-63 are in condition for allowance and respectfully requests that the same be allowed.

Respectfully submitted,

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